

tesa AG 687-WCG/HCL
3163-St-sti**REMARKS****Summary of Amendments Made**

Claim 10 has been amended. Claims 1-13 are still pending. It is believed that no new matter has been added.

35 U.S.C. 112, second paragraph rejections

Claim 10 has been amended to address the examiner's concerns. However, with respect to claims 5, 7, 9, 12 and 13, phrase which have been ascribed to these claims (i.e. "said application rate", unit of measurement for claims 12 and 13 stated to be only in grams) do not exist in these claims.

The claims on pages 3 and 4 of this communication represent the claims which are currently pending in this application. If there is a discrepancy between the applicants' file and the PTO's file, the applicants request that the Examiner call the undersigned representative below so that this discrepancy can be resolved.

35 U.S.C. 102(b) rejections

Claim 1 was rejected as being anticipated by applicants' admission set forth on page 3, lines 10-17. However, the examiner states that "The relied upon admission *clearly implicitly* recites the presence of an outer adhesive layer in lines 16-17 and the remainder of the admission *appear to clearly* read on the claimed invention."

However, the section referred to by the examiner only partially describes the film component of the applicants' invention. The "admission" fails to teach a tape or that the film is part of a composite backing or that the film is oriented, coextruded and at least a two-layer polypropylene film. Moreover, the recitation of adhesive composition details how the concept of the applicants' invention can be applied to similar films. There is no admission that it was known to add an adhesive composition to the films described in the paragraph (lines 10-17) of page 3 of the specification.

MPEP 2131 states that to anticipate a claim, the reference must teach every element of the claim

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and quotes from *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989) which states "The identical invention must be shown in as complete detail as is contained in the...claim." see also *In re Spada*, 15 USPQ2d 1655, (Fed. Cir. 1990) - "Rejection for anticipation requires, as first step in inquiry, that all elements of claimed invention be described in single reference, and such reference must describe applicant's claimed invention sufficiently to have placed person of ordinary skill in possession of it."

Given the differences between the "admission" and the claimed invention, the applicants' hold that the "admission" does not anticipate claim 1.

Claims 1, 2 and 4 were rejected as being anticipated by Crass et al. (U.S. Patent 4,673,611).

Crass et al. is relied upon as some elements of their invention is the same as the applicants claimed invention. However, Crass et al. lacks any teaching or suggestion for the applicants' limitation "wherein the cleavage strength of the composite backing is less than the bond strength of the adhesive." The Examiner asserts that the presence of an anti-adhesive substance inherently creates this structural limitation.

However, there is no teaching or suggestion from within the reference that such an inherent relationship exists and there is further factual evidence which supports this assumption of inherency. MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....**To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.** Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) – bold and italics added by author for emphasis.

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3163-St-eti**35 U.S.C. 103(a) rejection**

Claims 1-9 and 11-13 were rejected as being obvious over applicants' admission set forth on page 3, lines 10-17 and page 6, lines 9-12 taken either individually or alternatively for claim 3 in view of Allegre (FR 2,749,316).

The applicants response to the 102(b) rejection of claim 1 is to be considered repeated here. As Allegre and the admission of page 6, lines 9-12 ("admission 2") was used by the examiner for reasons which differ from the arguments presented against claim 1, Allegre and "admission 2) would not remedy the deficiencies of relying upon the "admission". However, Allegre and "admission 2" are briefly touched on below.

Allegre may disclose notches in the tape structure, but there is no teaching or suggestion from either "admission", "admission 2" or Allegre to combine these elements. MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990).

"Admission 2" merely states that certain adhesive technologies are known in the art. There is never any teaching or suggesting to combine this old component in the manner claimed by the applicants.

Claim 4 was rejected as being obvious over Crass et al., *supra*, in view of Allegre, *supra*.

Similar to the above response, Allegre is relied upon for reasons different than those argued against above with regard to the Crass et al. reference alone and as such would not remedy the deficiencies of Crass et al.

However, *in arguendo* even if Crass did teach all of the elements as asserted by the examiner above, Allegre may disclose notches in the tape structure, but there is no teaching or suggestion from Allegre to combine these elements. MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990).

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Claim 10 was rejected as being obvious over Freedman (U.S. Patent 5,876,816) in view of applicants' admission, *supra*.

Applicants are confused by this rejection as claim 10 is dependent upon using the adhesive tape of claim 1, i.e. if the Examiner believes that the combination of references render the method of use claim obvious, then the corresponding adhesive tape would also be obvious. In any event, Freedman suffers from similar deficiencies as the Crass et al. reference and further suffers from the fact that in order to obtain the "oriented, coextruded, at least two-layer polypropylene film" requires "picking and choosing" among the teachings of Freedman (it is unclear that Freedman teaches the "oriented" limitation).

Furthermore, while the applicants disagree with the Examiner's assessment of the "applicants' admission" for this rejection, even if this point was agreed upon, there is no motivation to combine the teachings as indicated by the examiner, i.e. "well within the skill of one of ordinary skill in the art" is not the proper standard for establishing a *prima facie* case of obviousness - MPEP 2143.01 states that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993)."

General

Except for the limitation of claim 3, it does not appear that the limitations of the applicants other dependent claims are taught by any combination of the references cited above. MPEP 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." (see also *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.